REMARKS

Applicants respectfully request reconsideration of the present U.S. Patent application. Claims 1-6, 8-14, 16-22 and 24 stand rejected under 35 U.S.C. § 103. Claims 1, 3-5, 10 and 17 have been amended. Claim 2 has been canceled. No claims have been added. Therefore, claims 1, 3-6, 8-14, 16-22 and 24 remain pending.

Claim Rejections - 35 U.S.C. § 103

Rejections of Claims 1-6, 8-14, 16-22 and 24 based on *Misra* in view of *Ginter* and *Pallakoff*

Claims 1-6, 8-14, 16-22 and 24 were rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,189,146 issued to Misra et al. (*Misra*) in view of U.S. Patent No. 5,892,900 issued Ginter et al. (*Ginter*) and U.S. Patent No. 6,269,343 issued to Pallakoff (*Pallakoff*). Claim 2 has been canceled without prejudice. Therefore, the rejection of claim 2 as being unpatentable over *Misra* in view of *Ginter* and *Pallakoff* is moot. For at least the reasons set forth below, Applicants submit that claims 1, 3-6, 8-14, 16-22 and 24 are not rendered obvious by *Misra* in view of *Ginter* and *Pallakoff*.

Claim 1 recites the following:

> a repository for storing a volume license agreement for a product, wherein the volume licensing agreement is obtained from a clearinghouse; ...

A proper rejection under 35 U.S.C. § 103 requires that a prior art reference, or references when combined, must teach or suggest all of the claim limitations of the rejected claim. See MPEP § 2143.

Misra discloses a software licensing system that includes a license generator located at a licensing clearinghouse, and at least one license server and multiple clients located at a company

or entity. See Fig. 1 and col. 2, lines 21-24. According to the Examiner, the license generator stores a volume licensing agreement. See Office Action, page 2, paragraph 5, lines 2-3.

Applicants do not concede that Examiner's characterization of *Misra*, as set forth in the Office Action, is correct. However, even if, according to Examiner's characterization of *Misra*, the license generator stores a volume licensing agreement, *Misra* does not teach a repository for storing a volume license agreement for a product, wherein the volume licensing agreement is obtained from a clearinghouse, as recited in claim 1. Specifically, if, as Examiner contends, the license generator in *Misra* stores a volume licensing agreement, the volume licensing agreement would not be obtained from a clearinghouse, since the license generator is located at the licensing clearinghouse.

Applicants agree with the Examiner that *Misra* does not teach or suggest a rules engine containing a set of rules for determining a discount step for the product in accordance with the volume licensing agreement; a pricing generator to calculate a purchase price for the product in accordance with the discount step and a purchase history, wherein the pricing generator determines whether the discount step is current and, if the discount step is not current, determines a new discount step and updates the purchase price; or a purchase generator to display a purchase price and transact a purchase of the product in response to a user request. See Office Action, page 3, lines 1-2; page 4, lines 1-2 and 8.

Pallakoff discloses a marketing method and system that aggregates demand and provides demand-based pricing, in which prices go down as the volume of units sold goes up. See col. 1, lines 53-55; col. 2, lines 27-28. If a number of demands for a product reaches a maximum limit, or if the number of demands exceeds a threshold amount by the end of a predetermined time period, a final price is determined based on predetermined prices associated with demand thresholds. See col. 8, lines 5-32. *Pallakoff* does not teach or suggest a repository for storing a

volume license agreement for a product, wherein the volume licensing agreement is obtained from a clearinghouse. Thus, *Pallakoff* fails to cure the deficiencies of *Misra*.

Ginter discloses a virtual distribution environment (VDE), wherein a licensing history is metered, so that a content provider can charge fees based on the total number of different properties licensed from the provider. See col. 20, lines 39-43. *Ginter* also discloses maintaining a usage history, for licensing or purchase discounts based on historical use. See col. 24, lines 9-18 and 24-31; col. 151, lines 53-57; col. 154, lines 5-11. However, *Ginter* does not disclose a repository for storing a volume license agreement for a product, wherein the volume licensing agreement is obtained from a clearinghouse. Thus, *Ginter* fails to cure the deficiencies of *Misra* and *Pallakoff*. Therefore, no combination of *Misra*, *Pallakoff* and *Ginter* teaches or suggests all the limitations of claim 1. Consequently, claim 1 is not rendered obvious by *Misra* in view of *Pallakoff* and *Ginter* for at least the reasons set forth above. Applicant therefore respectfully requests that the Examiner withdraw the rejection of claim 1 under 35 U.S.C. § 103.

Claims 3-6 and 8-9 depend from claim 1. Because dependent claims include the limitations of the claims from which they depend, Applicants submit that claims 3-6 and 8-9 are not rendered obvious by *Misra* in view of *Ginter* and *Pallakoff* for at least the reasons set forth above.

Claim 10 recites the following:

obtaining a volume licensing agreement for a product from a clearinghouse over a communications network; ...

Claim 17 is drawn to a computer-implemented method, and recites a similar limitation.

As explained above, no combination of *Misra*, *Pallakoff* and *Ginter* teaches or suggests obtaining a volume licensing agreement for a product from a clearinghouse over a communications network. Accordingly, *Misra* in view of *Pallakoff* and *Ginter* fail to teach or

suggest all the limitations of claims 10 and 17. Consequently, claims 10 and 17 are not rendered obvious by *Misra* in view of *Pallakoff* and *Ginter* for at least the reasons set forth above. Applicant therefore respectfully requests that the Examiner withdraw the rejection of claims 10 and 17 under 35 U.S.C. § 103.

Claims 11-14 and 16 depend from claim 10. Claims 18-22 and 24 depend from claim 17. Because dependent claims include the limitations of the claims from which they depend, Applicants submit that claims 11-14, 16, 18-22 and 24 are not rendered obvious by *Misra* in view of *Ginter* and *Pallakoff* for at least the reasons set forth above.

Examiner states that a "volume discount can be set as a pre-determin[ed] criterion of discounting," and/or based on "historical purchasing of end user activities base[d] on a license agreement," and that it would have been obvious to add to the "licensing management system" in *Misra* the "well-known practice of volume discount pricing ... in conjunction with a past purchasing history to calculate a discount level." See Office Action, page 5, lines 3-8.

Even if volume discount purchasing is a known business practice, that does not mean it would be obvious to add volume discount pricing to the software licensing system in *Misra*. Although an Office Action may suggest that an element of a primary prior art reference ***could*** be modified to form the claimed structure, the mere fact that the prior art ***could*** be so modified would not make the modification obvious unless the prior art suggested the desirability of the modification (emphasis added). In re Laskowski, 871 F.2d 115, 10 USPQ2d 1397 (CAFC 1989). There must be some supporting teaching in the prior art for the proposed modification to be proper. In re Newell, 891 F.2d 899, 13 USPQ2d 1248 (CAFC 1989). *Misra* does not teach or suggest adding volume discount pricing to a software licensing system.

CONCLUSION

For at least the foregoing reasons, Applicants submit that the rejections have been overcome. Therefore, claims 1, 3-6, 8-14, 16-22 and 24 are in condition for allowance and such action is respectfully solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application.

Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

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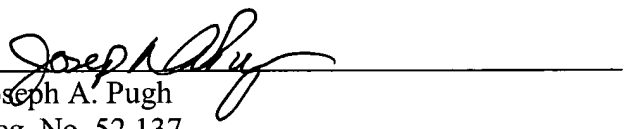

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